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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 09/940,462 | 08/29/2001 | Jean-Marie Stawikowski | 213287US6X | 5047 |
| 22850 | 7590 | 07/05/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | CHANKONG, DOHM | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2152 | |

DATE MAILED: 07/05/2006

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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/940,462

Filing Date: August 29, 2001

Appellant(s): STA Wikowski ET AL.

Gregory J. Maier and Edward Tracy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 13, 2006 appealing from the Office action

mailed October 14, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Linderman, U.S Patent Publication No. 2002/0032790

"Frequently Asked Questions about XML", Microsoft, June 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1> Claims 1-11, 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated over
Linderman, US 2002/0032790.

2> As per claim 1, Linderman teaches a communication system on an IP network ([0013]) between an automation equipment ([0013], wherein the automation equipment is for example, the server) comprising:

at least one processing unit capable of running a program ([0013], [0026], wherein the server has programs controllable by the remote devices) to provide automation functions [0053]; and

one or more remote devices (Fig 1, item 12; [0015]) running a computer program or group of computer programs (browser item 16, Fig 1),

wherein the communications system is based on the Simple Object Access Protocol (SOAP) for the purpose of providing the remote device with supervision, display, control, configuration or programming functions of the automation equipment ([0013], [0018]), and in that the communications system comprises, in the automation equipment, at least one WEB service ([0049]; T-BOX, Fig 1) or one WEB client which are capable of interacting with the program of the automation equipment of decoding messages received from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network ([0045-0046]).

3> As per claim 2, Linderman teaches the automation equipment includes at least one WEB service able to receive from the IP network requests ([0026]), coming from at least one WEB client application contained in a remote device and of sending on the IP network responses to the WEB client application of the remote device ([0045]).

4> As per claim 3, Linderman teaches the automation equipment includes at least one WEB client able to send on the IP network requests to at least one WEB server application contained in a remote device ([0026]; [0035]) and of receiving from the IP network responses, coming from the WEB server application of the remote device ([0045]).

5> As per claim 4, Linderman teaches a service description document describes the capacities of one or more WEB services implanted in an automation equipment ([0028-0030]), this service description document being accessible for a remote device either from its local resources, or from remote resources identified by a URL, URI or IP address ([0028-0030], [0040], [0049], wherein the user transmits service requests remotely to a server in order to carry out the request).

6> As per claim 5, Linderman teaches the service description document complies with a service description language referring to the SOAP protocol or to the HTTP, HTTPS protocol and providing a grammar based on the extensible Markup Language (XML) ([0018-0019], [0026]).

7> As per claim 6, Linderman teaches the service description document may contain one or more URL, URI or IP addresses of one or more WEB services ([0028-0030], wherein the name of the SNMP program is acting as an address, this will help identify the type of services required on the hierarchy).

8> As per claim 7, Linderman teaches the service description document complies with the Service Description Language (SDL) (wherein XML is a form of SDL language).

9> As per claims 8-10, the claims are rejected for the same reasons as rejection to claim 7 above.

10> As per claim 11, Linderman teaches several service description documents complying with different service description languages can describe the capacities of a same WEB service ([0042], [0043], wherein the different service description such as HTTP-SOAP protocol can describe the type of web services).

11> As per claim 13, Linderman teaches the service description document of an automation equipment is stored in storage means located in the automation equipment ([0034]; [0045]).

12> As per claim 14, Linderman teaches the service description document of an automation equipment is stored in storage means located in a remote device ([0034]; [0045]).

13> As per claim 15, Linderman teaches a generator is capable, following a request emanating from a remote device, of constructing a service description document dynamically, describing the capacities of one or more WEB services implanted in an automation equipment ([0036], wherein the incoming requests are handled dynamically since

NMA will build a model required to satisfy the incoming requests, further, the results are logged, wherein log will describe the status and capacities of the web services carried out).

14> As per claim 16, Linderman teaches the generator of a service description document of an automation equipment is accessible, for a remote device, via a URL, URI or IP address (again, the generator is accessible via the SOAP message, the contents of the SOAP message as well as the address identification was described previously above).

15> As per claim 17, Linderman teaches the generator of a service description document of an automation equipment is stored in storage means located in the automation equipment or in storage means located in a remote device ([0036], wherein the generator and the messages that it generated are all part of the remote device).

16> As per claim 18, the claim is rejected for the same reasons as rejection to combination of claims 1 and 15 above.

17> As per claim 19, the claim is rejected for the same reasons as rejection to combination of claims 1 and 15 above.

18> As per claim 20, the claim is rejected for the same reasons as rejection to combination of claims 1, 4 and 15 above.

Claim Rejections - 35 USC § 103

19> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20> Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linderman US 2002/0032790, in view of 'Frequently Asked Questions about XML', Microsoft', June 2000.

21> As per claim 12, Linderman does not explicitly teach compression of XML documents, specifically, even though this is implied as a form of encoding. However, Microsoft' teaches a service description document is compressed in a standard compression format for files and documents (see for example, pg 7, "Will it be necessary to compress XML for transmission over the web?"). It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Linderman and Microsoft' because the teaching of Microsoft' to allow a service description document compressed in a standard compression format for files and documents would improve the efficiency of document transport for Linderman's system by using compression standards within XML.

(10) Response to Argument

I. Summary of Applicant's arguments

Applicant argues that Linderman US patent publication 2002/0032790 [“Linderman”] is not prior art and only addresses the disclosure of Linderman’s U.S Provisional Application 60/208045 [“provisional ‘045”]. Applicant focuses the majority of the Appeal Brief discussing the T-BOX element disclosed in Linderman; Applicant argues that the provisional ‘045 does not disclose the T-BOX. Applicant then further argues that the provisional ‘045 does not provide an enabling disclosure. With respect to claims 15, 18 and 19, Applicant also argues that the provisional ‘045 does not disclose a service description document and its related functionality.

A. Linderman’s T-BOX element should benefit from the provisional ‘045’s priority date because the provisional ‘045 properly supports the subject matter relied upon to make the rejection

As a prior art reference, Linderman’s T-BOX is entitled to the benefit of its provisional application’s priority date because the provisional ‘045 properly supports the subject matter relied upon to make the rejection. The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions, if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. MPEP §2136.03(III). 35 U.S.C 112, first paragraph states that there shall be a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

enable any person skilled in the art to which it pertains to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Here, the provisional '045 discusses and supports the subject matter of the T-BOX element discussed in Linderman in compliance with 35 U.S.C 112, first paragraph. As discussed above, the test is whether the provisional '045 disclosure supports and describes in clear terms the T-BOX element in Linderman. Linderman discloses that the T-BOX is a translation box that translates SOAP commands into native languages of the intended device [0033]. Further, the T-BOX includes a parser and utilizes this parser to translate the responses received from network elements [0045]. Linderman discloses that SOAP commands are analogous to XML commands [0030, 0054].

The provisional '045, while not explicitly referring to the T-BOX element, discusses corresponding functionality that supports and clearly describes the subject matter. For example, the provisional '045 states that "DaberNet software installed on the server will run a parser filtering out the XML messages intended for the DaberNet, and will translate these messages into the necessary commands." Provisional '045, pg. 3 ¶2. The provisional '045 further states that the translation functionality includes "translation of the XML vocabulary into the necessary SNMP command." Id.

The provisional '045 describes the translation functionality in such a way that would enable one of ordinary skill in the art to make and use the invention. The provisional '045 describes the respective elements of the invention and specifically, the server side which is responsible for filtering out SOAP|XML messages and translating them into SNMP

commands. Thus, Linderman's T-BOX element is supported by the provisional '045 and Linderman's patent publication is entitled to the critical reference date of the provisional '045.

B. Linderman anticipates the claimed elements of claims 15, 18 and 19

Applicant argues that the provisional '045 fails to teach a service description document that describes the capacities of the Web services. As discussed above, Applicant argues erroneously that that Linderman is not prior art. The test is whether the subject matter relied upon in Linderman is supported by the provisional '045.

Linderman discloses dynamically discovering configurations of the network services (elements) [0037]. The dynamic discovery configuration information is stored in a database. The provisional '045 supports this functionality which discloses that the invention can be scaled to "include server configuration, and configuration of other network devices with specifications for network controllability". Provisional '045, pg. 3 ¶2. The configuration information thus contains specifications for how the network devices are to be managed and controlled. Therefore, Linderman's configuration information of the network devices is analogous to the claimed service description document.

C. Conclusion

Linderman's T-BOX element deserves the benefit of the provisional '045's filing date because the provisional '045 supports and describes in compliance with 35 U.S.C 112, first paragraph, the subject matter of the T-BOX element. Further, Linderman discloses the

claimed elements of claims 15, 18 and 19 and these elements are also should receive benefit of the provisional '045's filing date.

(ii) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

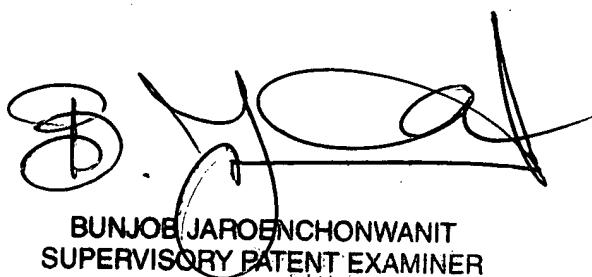
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DC

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